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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,990	11/25/2003	Andrew Arthur Gooley	FBR 20.750 (031035-00062)	7983
26304 7590 08/18/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER NAGPAUL, JYOTI				
ART UNIT 1797		PAPER NUMBER		
MAIL DATE 08/18/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/723,990

Applicant(s)

GOOLEY ET AL.

Examiner

JYOTI NAGPAUL

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Remarks filed on May 16, 2008 have been acknowledged. Claims 1-14 are pending.

Response to Amendment

Rejection of Claims 1-4, 8 and 10 are as being anticipated by Soulier (FR2148705) has been withdrawn in light of applicants' remarks.

Rejection of Claims 5-7, 9, and 11-14 as being unpatentable over Soulier in view of Scatizzi (EP 0945728) has been withdrawn in light of applicants' remarks.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: a reservoir 64 and clutch 62. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what the applicants' are referring to. There is no clear description of the clutch. Clarification is needed. Additionally, this claim appears to be a method limitation and is of no patentable significance in apparatus claims.

4. Claim 8 recites the limitation "the axis of movement", "the cylinders" and "the pistons". There is insufficient antecedent basis for this limitation in the claim.

Clarification is needed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
8. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minden (US 6342143) in view of Meltzer (US 5306510).

Minden teaches a sample retrieval apparatus comprising at least one cutting head (38) mounted on the apparatus for movement in X, Y and Z direction by an automated control system for excising a sample from an array. (See Col. 1, Lines 54-62)

Minden fails to teach one or more liquid aspiration and delivery outlet means for dispensing liquids onto the array of samples, a movable head mounted on an automated motion control system for controlling movement of the moveable head in X, Y, and Z directions, at least one displacement means connected to a liquid supply means and to one or more of the liquid aspiration and delivery outlet means via a valve means for causing the dispensing of liquid from the one or more liquid aspiration and delivery outlet means. Minden further fails to teach the at least one displacement

means and the one or more liquid aspiration and delivery outlet means are carried by the movable head. Minden further fails to teach at least one liquid aspiration and delivery outlet means comprises a pipette which is capable of receiving a removable tip.

Meltzer teaches a automated pipetting system comprising one or one or more liquid aspiration and delivery outlet means (27) for dispensing liquids onto the array of samples and at least one displacement means/syringe pumps connected to a liquid supply means and to one or more of the liquid aspiration and delivery outlet means via a valve means for causing the dispensing of liquid from the one or more liquid aspiration and delivery outlet means. (See Col. 8, Lines 36-53) Meltzer further teaches a movable head (14) mounted on an automated motion control system for controlling movement of the moveable head in X, Y, and Z directions and the at least one displacement means and the one or more liquid aspiration and delivery outlet means are carried by the movable head (14). (See Figure 1) Meltzer teaches the at least one liquid aspiration and delivery outlet means comprises a pipette which is capable of receiving a removable tip. (See Col. 3, Lines 5-7) Meltzer further teaches a plurality of syringes mounted in parallel on the moveable head (14). Meltzer further teaches a reservoir is connected to the moveable head by a single tube. (See Figure 2B) Meltzer further teaches a clutch means and pistons and therefore is clearly capable of operating in the same manner as recited in claim 8. (See Col. 8, Lines 63-69)

The combination of old elements in a single chassis is conventionally known in the art. It would have been obvious to one having ordinary skill in the art to provide one or more liquid aspiration and delivery outlet means on the moveable head as disclosed

in Meltzer with the cutting tool of Minden on a single chassis to achieve the predictable results decreasing the overall processing time of excising a sample and then dispensing or aspirating a solution onto the sample without using two different apparatuses but combining the two different apparatuses in a single chassis.

Response to Arguments

9. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection. Refer above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI NAGPAUL whose telephone number is (571)272-1273. The examiner can normally be reached on Monday thru Friday (10:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.